UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		09/841,465	HABERMAN ET AL.
		Examiner	Art Unit	
		MICHAEL VAN HANDEL	2424	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 June 2009</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
      Paper No(s)/Mail Date _____

4)☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 6/22/2009 has been entered.

Response to Amendment

2.   This action is responsive to an Amendment filed 6/22/2009. Claims **1-19** are pending.

Claims **1**, **8**, **10**, **12**, **13**, **16**, and **19** are amended. Claims **20**, **21** are canceled. The examiner

hereby withdraws the objections to claims **1-19** in light of the amendments.

Response to Arguments

3.   Applicant's arguments regarding claims **1**, **16**, and **19**, filed 6/22/2009, have been fully

considered, but they are not persuasive.

      Regarding claims **1**, **16**, and **19**, the applicant argues that the Office Action makes

conclusory statements and fails to provide any objective evidence from the prior art or elsewhere

that shows that the subject matter recited in independent claims 1, 16, and 19 would have been

obvious to a person having ordinary skill in the art. Applicant specifically argues that the Office

Action does not set forth a *prima facie* case, and that independent claims 1, 16, and 19 would not

have been obvious to a person having ordinary skill in the art. Applicant further specifically

argues that, because neither Ficco nor Klosterman et al. are concerned with saving storage space,

neither reference discloses a relationship between storage space and simultaneous data stream

transmission and one of ordinary skill in the art would not be motivated to combine Ficco and

Klosterman et al. The examiner respectfully disagrees.

The examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, it is well-known within the prior art that memory space is a constraining

factor in design. Despite Ficco's statement that one could store hundreds, thousands, or more

advertisements in memory, one of ordinary skill in the prior art would recognize that there still

remains a constraint on the number of advertisements to be stored. Klosterman et al. states that

advertisements can be selected from various possible locations (stored locally, accessible from

the Internet, or available over an alternative channel in real-time)(p. 4, paragraph 45 & p. 6,

paragraph 76). The alternative choices reflect tradeoffs in design between bandwidth, storage

space, and cost of implementation, for example. Given that memory space is always a

constraining factor in design, and that Klosterman et al. provides alternative means of acquiring

advertisements, the examiner maintains that one of ordinary skill in the art at the time that the

invention was made would have been motivated to combine the references as described in the

Office Action below.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims **1-5**, **8**, **9**, **12**, **13**, **15**, **16**, **18**, and **19** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ficco in view of Klosterman et al.

        Referring to claims **1**, **13**, **16**, and **19**, Ficco discloses a method/system for allowing the

creation of a plurality of personalized advertisements to be viewed by an intended audience (see

Abstract), comprising:

-       creating a personalized advertisement template comprising a plurality of media slots

        in sequence (originally broadcast advertisement), wherein a plurality of different

        media segments are insertable into at least one of said slots and wherein each of the

        different media segments is a portion of a personalized advertisement (p. 1, paragraph

        9; p. 2, paragraphs 23, 28, 35; p. 3, paragraph 47), each of the plurality of different

        media segments comprising one of: an audio segment (p. 4, paragraph 55), a video

        segment (p. 4, paragraphs 60, 61) , a graphics segment (p. 4, paragraphs 58-59), a

        rendering segment (p. 4, paragraphs 54, 57), and a segment of last minute information

        (p. 4, paragraph 60);

-       transmitting a plurality of data streams to a receiving unit, each data stream delivering

        a different one of said plurality of media segments for said at least one of said slots

(p. 2, 3, paragraphs 36-38), wherein said media segments are synchronized to begin
and end at substantially the same time (p. 3, paragraphs 45-47; p. 5, paragraphs 63-
65, 75); and

-    transmitting content selection information regarding content of said plurality of data
     streams to said receiving unit, said information including switch times for said
     plurality of synchronized media segments, wherein said receiving unit uses said
     content selection information to switch between said plurality of data streams to
     retrieve at least one of said media segments for each of said slots, to generate a
     customized broadcast transmission stream, thereby assembling said personalized
     advertisement (p. 2, paragraph 36; p. 3, paragraphs 45, 47; p. 5, paragraphs 63, 72,
     75).

Ficco further discloses replacing an entire originally broadcast advertisement with a selected ad

segment (p. 3, paragraph 46). Ficco does not specifically disclose that the plurality of data

streams are transmitted simultaneously. Klosterman et al. discloses systems and methods for

substituting alternative video and/or audio signals and/or graphics and/or text to be displayed on

a viewer's television display monitor for the video and/or audio signals that would otherwise be

displayed according to the channel to which the viewer has tuned the television set (see

Abstract). Klosterman et al. further discloses providing alternative advertisements on separate

simultaneously broadcast television channels, so that the receiver can tune between the different

channels to receive content best suited for a particular viewer (p. 2, paragraphs 31, 32; p. 4,

paragraphs 44-46). It would have been obvious to one of ordinary skill in the art at the time that

the invention was made to modify the ad segment transmission of Ficco to be simultaneously

transmitted on alternate channels with the original broadcast, such as that taught in the video

substitution system of Klosterman et al. in order to save storage space.

      Referring to claim **2**, the combination of Ficco and Klosterman et al. teaches the method

of claim 1, wherein said receiving unit selects among said plurality of data streams in real time

(on-the-fly)(Ficco p. 1, paragraph 7).

      Referring to claim **3**, the combination of Ficco and Klosterman et al. teaches the method

of claim 1, wherein said personalized advertisement is viewed by a viewer as it is assembled

(adapted on-the-fly as it is being broadcast)(Ficco p. 1, paragraphs 7, 9, 13; p. 2, paragraph 27; &

p. 3, paragraphs 46, 47).

      Referring to claim **4**, the combination of Ficco and Klosterman et al. teaches the method

of claim 1, wherein said receiving unit selects among said plurality of data streams based on said

content selection information and information about a viewer who will view said personalized

advertisement (Ficco p. 1, paragraphs 11, 12; p. 2, paragraph 26; p. 3, paragraphs 39, 40, 45-47;

p. 4, paragraphs 58, 59; & p. 6, paragraphs 85-89).

      Referring to claim **5**, the combination of Ficco and Klosterman et al. teaches the method

of claim 4, further including providing a data stream with a default personalized advertisement to

allow said receiving unit to display said default personalized advertisement without selecting

between said plurality of data streams (Ficco p. 3, paragraph 46; p. 5, paragraphs 71-74; & Fig.

5).

      Referring to claim **8**, the combination of Ficco and Klosterman et al. teaches the method

of claim 1, wherein said segments are incomplete parts of said personalized advertisement (Ficco

p. 1, paragraph 9 & p. 3, paragraph 47).

Referring to claim **9**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said receiving unit is a set top box (Ficco p. 1, paragraph 8).

Referring to claims **12** and **18**, the combination of Ficco and Klosterman et al. teaches the method/system of claims 9 and 16, respectively, wherein said set top box momentarily switches from a first digital data stream to a second digital data stream to play out said personalized advertisement (Ficco p. 5, paragraph 75).

Referring to claim **15**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, further including a plurality of templates for creating said personalized advertisements, wherein said templates include video sequence templates and audio sequence templates (Ficco p. 4, paragraph 62).

6.   Claim **6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al. and further in view of Ten Kate et al.

Referring to claim **6**, the combination of Ficco and Klosterman et al. teaches the method of claim 1. Klosterman et al. does not disclose that the plurality of data streams are MPEG encoded data streams. Ten Kate et al. discloses encoding video streams in MPEG-2 (col. 3, l. 39-41, 61-67). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the transmission channels in the combination of Ficco and Klosterman et al. to be MPEG encoded, such as that taught by Ten Kate et al. in order to achieve a higher compression rate.

7.   Claims **7**, **10**, **11**, **17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco

in view of Klosterman et al. and further in view of Picco et al.

        Referring to claim **7**, the combination of Ficco and Klosterman et al. teaches the method

of claim 1. The combination of Ficco and Klosterman et al. does not specifically teach that the

plurality of data streams are multiplexed into a transport stream. Picco et al. discloses

multiplexing live television feeds 106, local content streams 108 and various other signals into a

digital data stream that is then transmitted to a user (col. 8, l. 56-67 & Fig. 5). It would have

been obvious to one of ordinary skill in the art at the time that the invention was made to modify

the transmission channels in the combination of Ficco and Klosterman et al. to be multiplexed

into a digital data stream, such as that taught by Picco et al. in order to provide individualized

local content in a digital stream by transmitting to the user a single multiplexed data stream

(Picco et al. col. 2, l. 42-44).

        Referring to claims **10**, **11**, and **17**, the combination of Ficco and Klosterman et al.

teaches the method/system of claims 9 and 16. The combination of Ficco and Klosterman et al.

further teaches that the invention can receive analog television and digital television (Ficco p. 2,

3, paragraphs 37, 38). The combination of Ficco and Klosterman et al. still further discloses

switching advertisements in response to a channel change command in the vertical blanking

interval (VBI)(Ficco p. 2, 3, paragraphs 36, 37 & Klosterman et al. p. 3, paragraph 38). The

combination of Ficco and Klosterman et al. does not specifically teach that the set top box

momentarily switches from an analog data stream to a digital data stream to play out said

personalized advertisement triggered by VBI data. Picco et al. discloses a set top box 120 (Fig.

7) that can receive both analog data streams and digital data streams (col. 14, l. 62-67). Picco et

al. further discloses that the set top box 120 activates a web browser in response to a user

selection when the user sees a television advertisement, which references a particular web site

(col. 14, l. 17-41 & Fig. 11). It would have been obvious to one of ordinary skill in the art at the

time that the invention was made to modify the VBI triggered advertisement switching of

Klosterman et al. to include switching from an analog stream to a digital stream to display

advertising information, such as that taught by Picco et al. in order to provide a television viewer

with advertising from the Internet.

8.   Claim **14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of

Klosterman et al. and further in view of Kunkel et al.

        Referring to claim **14**, the combination of Ficco and Klosterman et al. teaches the method

of claim 1. The combination of Ficco and Klosterman et al. does not specifically teach including

transition segments, which are inserted into a personalized advertisement between segments.

Kunkel et al. discloses encoding video streams in MPEG1 or MPEG2. It would have been

obvious to one of ordinary skill in the art at the time that the invention was made to modify the

transmission channels in the combination of Ficco and Klosterman et al. to be MPEG encoded,

such as that taught by Kunkel et al. in order to achieve a higher compression rate. Kunkel et al.

further discloses sending I-frames continuously at the beginning of targeted ads, so that the set

top box tuners can quickly acquire the signal. Similarly, a continuous stream of I-frames is

provided for the last few seconds of the advertisement to enable the tuners to quickly reacquire

the original channel once the advertisement has concluded (p. 4, paragraph 31). It would have

been obvious one of ordinary skill in the art at the time that the invention was made to modify

the combination of Klosterman et al. and Kunkel et al. to include continuously sending I-frames

at the beginning and end of advertisements, such as that taught by Kunkel et al. in order to

facilitate seamless transitions between advertisements and original programming (Kunkel et al.

p. 4, paragraph 31).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MICHAEL VAN HANDEL whose telephone number is

(571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Van Handel/
Examiner, Art Unit 2424

8/05/2009